

REMARKS

Claims 12-20 are pending in the application. Claims 12-20 have been rejected. Claims 12, 13, and 16 herewith are amended. Claims presently active are claims 12-20.

Amendments

Claims 12 and 16 have been amended to correct a typographical error: “second side of the printer” has been corrected to “second side of the media.”

Claim 12 has been amended to advance prosecution, as described below with reference to the §112 rejection. Specifically, the preamble now provides that the printer is operable in at least a duplex-printing mode (pg. 4 lines 25–27). The printer includes a jam sensor for detecting a paper jam (e.g., pg. 4 lines 5–7). A control arrangement is provided for activating the printer (pg. 3 line 32–pg. 4 line 1) and directing the print media through the printer. The control arrangement therefore is capable of determining whether duplex-printing mode has been completed; i.e., whether only one side of the print media has been printed.

The control arrangement performs this function, as is clearly the result of the control arrangement’s operation of the internal systems of the printer (e.g., pg. 4 lines 8–11, pg. 5 lines 10–14 and 20–21, pg. 6 lines 3–5, pg. 7 line 1). It is well-known in the art that a control arrangement should be used to sequence pages through the printer. For example, US 6,144,818 to Ohtani, having a US priority date of September 8, 1998, discloses that “an image processing main controller 14 included in the printer 1 controls paper feed and paper discharge in response to the commands received from the printer controller 10” and that “the image forming section 12 feeds a staple command, a stapling pattern, duplex copy command and so forth to the image processing main controller 14.” Applicant therefore believes the specification as filed met all the requirements of §112 for the feature of the control arrangement “directing the print media through the printer.” (Applicant notes that US 6,144,818 is directed to stapling, and that claims 12 and 16, and their

dependent claims, are believed to be novel and non-obvious over the cited references plus Ohtani.)

Claim 13 now sets forth that the printer is further operable in a simplex-printing mode (pg. 4 lines 4–5). The control arrangement of parent claim 12 determines when duplex printing is complete or when printing on one side or the other is complete, as discussed above. Likewise, the control arrangement in claim 12 determines when one side of the print media has been printed as set forth in claim 14.

Claim 16 now sets forth that the printing is accomplished using a printer (pg. 1 lines 8–9). Claim 16 also sets forth directing the media through a transport path using a control arrangement, as described above in reference to claim 12.

§112 Rejections

Claims 12-20 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as his invention. Applicant notes that MPEP 2172.01, cited in the Office Action, is based on *In re Mayhew*. This case reads, in pertinent part, “it is clear that [the Examiner] was relying on § 112, paragraph one, which requires that claims be supported by an enabling disclosure” (527 F.2d 1229, 1232). Applicant therefore respectfully reiterates his traverse of these rejections filed July 20, 2010. None of the cited features were disclosed as essential in the specification to provide any grounds for a non-enablement rejection based on their omission from the claims.

However, Applicant notes that section 4 of the Office Action clarifies that the rejection is a clarity rejection, *not* a non-enablement (e.g., MPEP 2172.01) rejection. In the interest of advancing prosecution of this application, therefore, Applicant has amended claims 12, 13, and 16 as described above. Applicant believes these amended claims, and the other claims in the case, conform fully to §112. Applicant’s Agent respectfully requests a telephone call if the Examiner disagrees.

§102, §103 Rejections

Claims 12-14, 16-17, and 19-20 stand rejected under 35 U.S.C. 102(b) as being anticipated by Stoll (US 6,550,762). The rejection is traversed.

Referring to Stoll FIG. 3 and to page 5 of the Office Action, if a paper jam is detected (via sensor 101B), print media in which only one side has been printed cannot possibly “continue through the transport path (including 13, 15B, 17B, 19B, and unnumbered dotted-line path connected to 19B)” (Office Action pg. 5, item (b), emphasis added). A jam detected at sensor 101B means that paper is jammed in front of the sensor, so a second sheet cannot travel through feed rolls 17B. Moreover, depending on the position of the jam, bypass gate 18B may be blocked from operating, and bypass gate 18B must operate to move print media from inverter entrance path 15B to exit path 19B. Stoll therefore cannot permit the print media in which only one side of the print media has been printed to continue through the transport path, as set forth in claims 12 and 16.

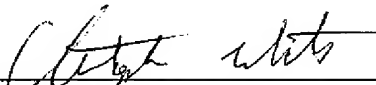
Moreover, inverter chute 16A, cited in Office Action pg. 5, item (c), is not a container, and interpreting it as such is not consistent with the specification of the present invention. Page 3 line 6 states that the container receives waste printing material. However, inverter chute 16A receives, and then disgorges, every sheet of print media that is to be printed in duplex, waste or not. Moreover, chute 16A only holds the sheet for a short time, so does not contain any sheets (col. 6 lines 39–50). Since chute 16A is not a container, entrance path 15A is not an exit in the sense of claims 12 and 16. Similarly, chutes 45A, 45B of Stoll FIG. 8 and col. 9 are not containers. In any case, even if chute 16A were a container, it would definitely be a container within the transport path, not outside the transport path as set forth in the claims (Stoll col. 6 lines 42–48).

Stoll does not include the first-side-printed media continuing through the transport path, or the container not within the transport path, as set forth in claims 12 and 16. These claims are therefore believed to be novel and non-obvious over Stoll. The remaining claims depend from these and should be allowed with them.

Claims 15 and 18 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Stoll as applied to claims 12 and 17 above, and further in view of Carter (US 6,341,777). These claims depend from claims 12 and 16, respectively, and should be allowed with them.

In view of the foregoing remarks and amendment, the claims are now deemed allowable and such favorable action is courteously solicited. Should the Examiner consider that additional amendments are necessary to place the application in condition for allowance, the favor is requested of a telephone call to the undersigned agent for the purpose of discussing such amendments.

Respectfully submitted,



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If the Examiner is unable to reach the Applicant(s) Agent at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.

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